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of the thickness --.

Claim 10,

line 2 of the claim, delete "1 to 20" and insert therefor -- 5 to 10 --.

line 3 of the claim, delete "80%" and insert therefor -- 90% --.

### REMARKS

The claims under examination are 1 to 10. Applicants reserve the right right to file a division application with respect the subject matter withdrawn from consideration, i.e., claims 11 and 12, under the provisions discussed in *Studiengesellschaft Kohle mbH v. Northern Petrochemical Co.*, 784 F.2d 351, 355, 228 USPQ 837, 840 (Fed. Cir.), *cert. dismissed* 478 U.S. 1028 (1986).

#### The examiner's criticism of applicants PTO-1449

The examiner has crossed out those references cited by applicants in their IDS, Form PTO-1449, apparently because applicants have not included the English language explanation required by 37 CFR 1.98(c)(3).<sup>1</sup> Applicants will endeavor to provide such as soon as possible.

However, as noted by applicants in their communication of February 3, 2001, the necessary explanation of DE-A 1 97 22 339 is found in applicants' disclosure at page 2, lines 1-8 and no further explanation should be required according to the rule.

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<sup>1</sup> The rule requires "A concise explanation of the relevance, as it is presently understood by the individual designated in §1.56(c) most knowledgeable about the content of the information, of each patent, publication, or other information listed that is not in the English language. The concise explanation may be either separate from the specification *or incorporated therein* [Emphasis added]."

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The amendments to the specification

The specification has been amended to conform to the examiner's suggestion regarding the arrangement of the specification.

The amendments to the claims

Support for the above amendments to claims 1 and 10 is found in the specification at p. 4, lines 33-35.

The rejections over prior art

The examiner rejects over prior art as follows:

1. Claims 1, 3-5 and 8 under 35 USC § 102(b) (lack of novelty) as anticipated by Miyakoshi (US 5,827,788).
2. Claims 2 and 10 under 35 USC § 103(a) (obviousness) over Miyakoshi.
3. Claims 6 and 7 over Miyakoshi in view of Madea (US 4,772,496).
4. Claim 9 over Miyakoshi in view of Gleim (US 5,976,671).

Regarding rejection 1, it is well settled that under 35 USC 102, every element of claimed invention must be met by the reference without reference to any other source. *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 USPQ 81, 90 (Fed. Cir. 1986), *cert. denied*, 480 U.S. 947 (1987). Lacking from the reference is, inter alia,

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the thickness limitation, discussed in more detail below. Accordingly the reference does not anticipate under 35 USC § 102.

Miyakoshi, the examiner's primary reference, pertains to a recoatable decorative laminate comprising a recoat layer of a nonwoven fabric placed on top of a substrate sheet of thermoplastic polymer (see col. 3, detailed description of invention, and col. 4, lines 41 ff). Miyakoshi describes also the presence of a protective layer composed of a curable resin such as thermosetting resin placed on top of the recoating layer (see col. 7, lines 1 to 15). Such protective layer improves the abrasion resistance and prevents fuzzing of the nonwoven recoating layer (col. 7, lines 2 and 3).

However, the Miyakoshi citation discloses laminates which are used for furniture and similar applications (see col. 1, lines 5 to 10). For such applications, the thickness of the laminates has to be fairly thin. Along with Miyakoshi the thickness is specified in the range of from 80 to 150  $\mu\text{m}$ -thick PVC film.

Additionally, the curable protection layer as mentioned in col. 7 has to be very thin, because otherwise it inhibits the permeation of colorant into the nonwoven fabric (see col. 7, lines 15 to 18).

As to rejection 2, applicant's invention is more than a "mere duplication of the essential working parts of a device"<sup>2</sup> and more than a "mere change in size" or degree

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<sup>2</sup> *St. Regis Paper Co. v. Bemis Company, Inc.*, 193 USPQ 8 (CA7 1977) cited by the examiner is directed to the concept of "aggregation" or "old combination." However, the concept of "old combination" as a rejection is improper as note MPEP 2173.05(j). "Aggregation" requires a particular set of circumstances not present here, MPEP 2173.05(k).

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as conjectured by the examiner. Rather, it is an entirely novel and unobvious structural layer composite.

The case cited by the examiner, *In re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955) -- discussed at MPEP 2144.04(IV)(A) along with other similar cases -- is inapposite to the facts in the instant application. In *Rose* the question involved was merely a change in the size of a package of lumber to be carried. Applicants invention, as discussed in more detail below, involves a distinct product which, among other things, has a different function -- the products are useful and floor coverings and wall panels.

The inventors were very surprised, that a strong connection between the decorative layer adhered to the heat curable layer of the thermosetting material, both of them provided as a thin film, and the thermoplastic support layer could be achieved by in-mold coating along with the present invention. Miyakoshi, in contrast thereto, describes the application of the layers to the thermoplastic support film by some printing techniques.

Since Miyakoshi, the examiners primary reference (Cf. MPEP 2143.01), teaches only sheet-like materials for furniture and the like, being necessarily or less flexible, the thickness of the layered composite materials of the present invention is essential for its function as decorative floor coverings or wall panels.

The inventors deemed the layered composite of this invention to be novel, since the thickness of the support layer is higher to render stiffness to the layered

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composite, rather than flexibility. Such stiffness is necessary for the intended use of the layered composite material.

Additionally, the thickness of the curable layer of the present invention, the thermosetting resin, is much higher to render the layered composite not only abrasive resistant (as taught by Miyakoshi), but also scratch resistant and resistant against environmental effects such as chemical influences and even heat resistant against cigarettes (see page 2, lines 5 to 10). The protective layer of the present invention has a completely other function compared with the protective layer disclosed by Miyakoshi, the latter should be permeable for colorants.

Nor do either of the secondary references, as used in rejections 3 and 4, overcome the shortcomings of Miyakoshi for making out the necessary case for prima facie obviousness.

The Maeda reference is cited to teach, allegedly, that polyoxymethylene is functionally equivalent to polystyrene or polybutylene terephthalate. However, such functional equivalence should properly be limited to printed circuit boards which is the subject of Maeda's invention. Also the fillers disclosed in col. 17 and 18 are deemed to be relevant for the needs of printed circuit boards, whereas the present invention pertains predominantly to decorative floor coverings or wall panels.

The Gleim reference also describes more or less flexible laminates based on polyvinylidene fluoride decorative laminates. The Gleim reference is cited in connection with claim 9 to show that thermosetting resin is cured during the hot press cycle during

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the laminate's construction. However, Gleim does describe only the fluorinated polymer as embossable substrates which are not mentioned as polymers for the substrate layer of the composite material of the present invention.

It is thus apparent that the references applied by the examiner do not make out the necessary prima facie case for obviousness. Accordingly, allowance is respectfully solicited.

A check for \$110.00 is attached for a one month extension of time. Should this check be deficient, kindly charge Deposit account No. 11-0345.

Respectfully submitted,

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**MARKED UP VERSION OF AMENDED CLAIMS**

1. (amended) A layered composite with at least one decorative surface and comprising a backing layer made from a thermoplastic polymer which is not polypropylene, a decorative layer arranged thereupon and a heat-cured layer applied to the decorative layer wherein the total thickness of the layered composite is from 1 to 20 mm and whose backing layer makes up at least 80% of the thickness.

10. (amended) A layered composite as claimed in claim 1, whose total thickness is from [1 to 20] 5 to 10 mm and whose backing makes up at least [80%] 90% of the total thickness.